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Total Number of Pages in This Submission

22

Application Number

10/526,843

Filing Date

03/03/2005

First Named Inventor

Chenghui Luo

Art Unit

2135

Examiner Name

Gyorfi, Thomas

Attorney Docket Number

fraunh01.049

### ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
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<input checked="" type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
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Remarks

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Gordon E. Nelson, Patent Attorney, PC		
Signature	/Gordon E. Nelson/		
Printed name	Gordon E. Nelson		
Date	12/24/2008	Reg. No.	30,093

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fraunh01.049

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
(fraunh01.049)

<b>Applicant:</b>	Luo, et al.	<b>Confirmation no:</b>	9357
<b>Application No:</b>	10/526,843	<b>Group Art Unit:</b>	2135
<b>Filed:</b>	3/3/2005	<b>Examiner:</b>	Gyorfi, Thomas A.

**Title:** *Protecting mobile code against malicious hosts*

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Response to a final Office action under 37 C.F.R. 1.116**

**Status of the prosecution**

*Prosecution of the PCT application*

The above application is the U.S. National Phase of PCT/US03/27693, which received a *Written Opinion* under PCT Rule 66 mailed May 28, 2004. In the *Written Opinion*, the IPEA/US examiner found that dependent claims 5, 11-13, 19-21, and 27-29 fulfilled the requirements of PCT Article 33(2 and 3) and that claims 1-4, 6-10, 14-18 and 22-26 did not fulfill the requirements of PCT Article 33(2 and 3) because the limitations of the claims were completely disclosed in the reference Monden et al, *Watermarking Java Programs*, published 1999 and the substantially similar reference Monden et al., *A practical method for watermarking Java programs*, published in 2000 by the IEEE as 0-7695-0792-1, termed hereinafter "Monden", completely disclose what is claimed in those claims.

Applicants responded to the *Written Opinion* on 7/23/2004 with a traversal of the rejections of claims 1-4, 6-10, 14-18, and 22-26. The traversal made two points:

- Monden contains substantially no disclosure of the limitations of Applicants' independent claims which appear in the following form in claim 1:

one or more obfuscated names that correspond to system symbolic names;

a first association between the obfuscated names and encrypted forms of the corresponding system symbolic names; ...

the execution environment including a second association of the encrypted forms with information needed to resolve the corresponding system symbolic names, using the first and second associations to resolve the obfuscated names, ...

- Monden's static watermarking is done to provide an identification of the owner of the code, not to determine whether the code being executed has been modified either on the way to the system that is executing it or with the system that is executing it.

#### *The first Office action in the US application*

The above application entered the U.S. national phase on 3/3/2005. Examiner mailed a first Office action in the application on 04/04/2008 in which he rejected claims 1-5 and 22-29 under 35 U.S.C. 101 as addressed to "software *per se*" and consequently as not addressed to patentable subject matter. Examiner further rejected claims 1-29 under 35 U.S.C. 103 as anticipated by Monden, *supra*, in combination with Valdez, et al., *Software Disengineering: Program Hiding Architecture and Experiments*, IH 99, A Pitman, (Ed.): IH'99, LNCS 1768, pp. 379, 394, Berlin, Heidelberg, 2000 (henceforth "Valdez"). Applicants amended claims 1-5 and 2-29 to overcome the rejection under 35 U.S.C 101, amended claim 1 to more clearly distinguish it from Monden, and traversing the rejection of claims 1-29 under 35 U.S.C 103. Applicants further corrected an error in the title as listed in the filing receipt.

#### *The final Office Action in the US application*

In the final Office action, mailed 9/24/2008, Examiner no longer maintained the rejection under 35 U.S.C. 101 but persisted in his rejection of claims 1-29 under 35 U.S.C. 103 as unpatentable over the combination of Monden and Valdez. Examiner further added two new references to the rejection, namely Collberg, et al., *A functional taxonomy for*

*software watermarking*, in: ACSC2002, “Conferences in Research and Practice in Information Technology”, vol. 4, ed. Michael Oudshoorn, Melbourne, Australia, 2002, henceforth “Taxonomy”, and *How to write Doc comments for the Javadoc tool* (henceforth “Javadoc”). Applicants are amending claim 1 to correct an error made in the last amendment, again traversing the rejection under 35 U.S.C. 103, and are further requesting that Examiner either allow the claims as amended in the response to the first Office action or withdraw the finality of the final rejection of 9/24/2008.

**Please amend the claims as follows:**